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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,938	04/05/2001	John W. Daniel	104.025	3811
7590	05/05/2005		EXAMINER	
Law Office of Jerome D. Jackson 211 N. Union Street, Suite 100 Alexandria, VA 22314			RETTA, YEHDEGA	
			ART UNIT	PAPER NUMBER
			3622	
DATE MAILED: 05/05/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/825,938	DANIEL ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Yehdega Retta	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 27 January 2005.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 2-10, 12-18 and 28-30 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 2-10, 12-18, 28-30 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This office action is in response to amendment filed January 27, 2005. Claims 2-4, 6 and 7 are amended, claims 1, 11 and 19 are canceled and claims 28-30 are added.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant, in claim 2, claims "selectively enabling a price adjustment for a second purchase" and in claims 3, 4 and 6 claims "the price adjustment being an increasing function of the numerical value". It is understood that the feature claimed in claim 2, enabling a price adjustment for a second purchase, does not mean providing discount for a second purchase but increasing point or value in the card (as indicated in the dependent claims), therefore, it is not clear what fund is transferred from the manufacturer to the retailer since no discount is provided.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulze, Jr., U.S. Patent No. 6,497,360 and further in view of Official Notice.

Regarding claim 2, Schulze teaches enabling a discounted purchase responsive to a previous purchases with a retailer, generating a signal corresponding to a transfer of funds from a manufacturer to the retailer (see col. 5 line 8 to col. 6 line 42, col. 7 lines 1-57, col. 8 line 55 to col. 9 line 7). Schulze teaches redeeming coupons or discount, however does not explicitly teach the discounted purchase being in responsive to a previous purchase. However, Official Notice is taken that is old and well known in the art of marketing to provide discount based on product purchased previously. Discounts, such as buy one get the next item free or half price is well known in retail stores. Thus it would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to provide such promotion since providing a discount on a second product encourage customers to buy the second product.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-6, 8-16, 18-25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorf U.S. Patent No. 6,000,608 in view of Schulze, Jr., U.S. Patent No. 6,497,360.

Regarding claim 2, Dorf teaches effecting a first purchase with a retailer, enabling a price adjustment for a second purchase responsive to a first purchases, effecting the second purchase; effecting the first purchase in one store and effecting the second purchase in another store; (see col. 9 line 25 to col. 10 line 6). Dorf does not explicitly teach generating a signal corresponding to a transfer of funds from a manufacturer to the retailer, wherein the manufacturers are in

mutual competition etc, it is taught in Schulze (see col. 5 line 8 to col. 6 line 42, col. 7 lines 1-57, col. 8 line 55 to col. 9 line 7). Schulze teaches manufacturer reimbursing the retailer for the discounted purchase made by the customer (see abstract). Thus it would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to combine Dorf's points redemption and Schulze's manufacturer reimbursement of coupons in order to reimburse the retailer the discount extended to customers.

Regarding claims 3 and 6, Dorf teaches enabling the price adjustment includes increasing a numerical value the first purchase increasing points in customer's card (see col. 9 line 25 to col. 10 line 6).

Regarding claim 4, Dorf teaches enabling the price adjustment and effecting the second product does not reduce the numerical value or reduce the numeric value (see col. 9 line 25 to col. 10 line 6 and col. 15 lines 60-65).

Regarding claim 5, Dorf teaches effecting plurality of purchases and generating a signal and comparing the signal to a threshold (see col. 9 line 25 to col. 10 line 6).

Regarding claims 8-10, Dorf teaches effecting a first purchase with a retailer, enabling a price adjustment for a second purchase responsive to a first purchases, effecting the second purchase; effecting the first purchase in one store and effecting the second purchase in another store; (see col. 9 line 25 to col. 10 line 6). Dorf does not explicitly teach generating a signal corresponding to a transfer of funds from a manufacturer to the retailer, wherein the manufacturers are in mutual competition etc, it is taught in Schulze (see col. 5 line 8 to col. 6 line 42, col. 7 lines 1-57, col. 8 line 55 to col. 9 line 7). Schulze teaches manufacturer reimbursing the retailer for the discounted purchase made by the customer (see abstract). Thus it would have

been obvious to one of ordinary skill in the art at the time of applicant's invention was made to combine Dorf's points redemption and Schulze's manufacturer reimbursement of coupons in order to reimburse the retailer the discount extended to customers.

Claims 12-16, 18, 20-25 and 27 are rejected as stated above in claims 2, 3-6.

Regarding claims 28-30, Dorf teaches selectively enabling a price adjustment includes reading a signal from a customer card (col. 9 lines 25-53)

Claims 7, 17 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorf U.S. Patent No. 6,000,608 in view of Schulze, Jr., U.S. Patent No. 6,497,360 and further in view of Official Notice.

Regarding claims 7, 17 and 26, Dorf and Schulze teaches retail stores selling products. Both Dorf and Schulze do not explicitly disclose the retail store displaying a discount level for products and affecting purchase in accordance with the display. Official Notice is taken that is old and well known in the art of retail store to display discount level for product and to effect the purchase according to the displayed discount. One would be motivated to display discount level of a product in order to inform customer of the discount in order to entice the customer to buy the product and to charge the customer accordingly.

#### *Response to Arguments*

Applicant's arguments filed January 27, 2005 have been fully considered but they are not persuasive.

Applicant argues that in Dorf's the data is transmitted to processing hub and the hub credits the loyalty card database and there would have been no reason to generate a signal corresponding the fund transfer from a manufacturer to the retailer. Applicant is correct that if

there is no discount provided to the customer the manufacturer would not reimburse the retailer since only points or credits was provided for purchasing products, as in Dorf. However if a discount were provided for the second product it would be obvious to reimburse the retailer. If the retailer is providing discount for second purchase and also increasing the value on a card, it would be obvious to provide reimbursement for the discount extended to the customer as taught in Schulze and increase the value on a card as taught in Dorf. Claim 2, as stated above (see under 112), recites selectively enabling a price adjustment for a second purchase and generating a signal corresponding to a transfer of funds from the manufacturer to a retailer. If in this case the enabling of a price adjustment for a second purchase means that the price is adjusted due to providing discount, than the retailer, would be reimbursed by the manufacturer. However if the price adjustment for a second product is achieved by providing credit on a card, as indicated by the dependent claims, then the manufacturer would not need to reimburse the retailer since the retailer is not selling the product at a reduced price, however would be reimbursed when the customer redeems the points (credit) by purchasing products at the retailer.

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 3622

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
RETTA YEHDEGA  
PRIMARY EXAMINER  
Art Unit 3622

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